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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,643

10/13/2005

Masayuki Iwakubo

267275US0PCT

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12/05/2008

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EXAMINER

DAVIS, ZINNA NORTINGTON

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

12/05/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,643	<b>Applicant(s)</b> IWAKUBO ET AL.	
	<b>Examiner</b> Zinna Northington Davis	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-14 are pending.
2. In the response filed August 7, 2008, Applicants have elected Group I, claims 1-12, without traverse.
3. Applicants also identify the compound of Formula I wherein Q is phenyl and p is 2.
4. Based upon the response, the election of species requirement is withdrawn. Claims 1-12 are examined as a whole.
5. Claims 13 and 14 are withdrawn from consideration. These claims have not been canceled.
6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

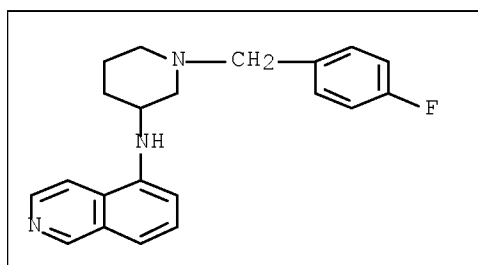
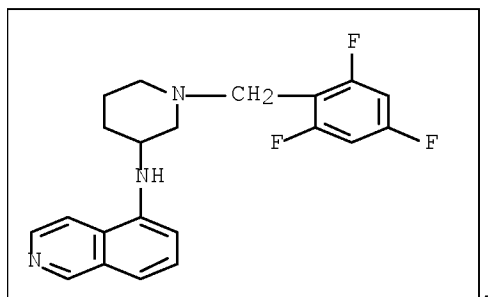
A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

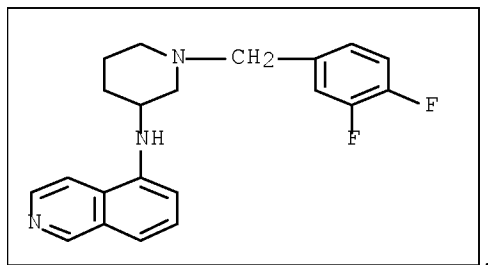
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8. Claims 1-3, 6, and 8-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kirin Beer Kabushiki Kaisha (Reference AO, cited by Applicants) which is equivalent to Reference A (cited by the Examiner).

The instantly claimed compounds are disclosed. At page 310, see compound 276. At page 314, see compounds 297 and 301. The compounds are depicted below:



, and



9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirin Beer Kabushiki Kaisha (Reference AO, cited by Applicants) which is equivalent to Reference A (cited by the Examiner).

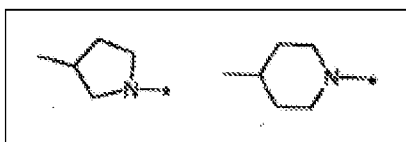
The instantly claimed compounds are disclosed. At page 310, see compound 276. At page 314, see compounds 297 and 301. The difference between the prior art compounds and the instantly compounds is the selection of the various radicals which are substituted.

Reference A teaches the compounds of formula, Het--X--Z. The radicals are defined as follows:

1) At page 12, see formula (III f), Het represents an isoquinoline ring which is



depicted as follows:



2) At page 16, X is , and

3) At page 3, Z is  $\text{--N(--R}^1\text{)--Q6--Q7--}$  where R<sup>1</sup> hydrogen, Q6 and Q7 is a direct bond.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify compounds 276, 297, and 301. One of ordinary skill in the art would have been motivated to do this to obtain another of the pharmaceutical compounds preferred by Reference A, especially since the reference clearly suggested

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that such substitutions would produce a compound with similar properties.

Based upon the teachings of Reference A, one of ordinary skill in the art of general chemistry would expect that modifying one radical for another would not change the properties of a compound in a significant way. As such, the instantly claimed invention is unpatentable therefrom.

11. The Information Disclosure Statement filed March 14, 2005 has been considered.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

13. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/  
**Zinna Northington Davis**  
**Primary Examiner**  
**Art Unit 1625**